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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10721,359	11/26/2003	Hisashi Ohtsuki	1761.1052	6144
21171	7590	01/24/2007	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			JOYCE, WILLIAM C	
			ART UNIT	PAPER NUMBER
			3682	
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE		DELIVERY MODE	
3 MONTHS	01/24/2007		PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/721,359	OHTSUKI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	William C. Joyce	3682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 26 November 2006.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1,3,4 and 7-9 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3,4 and 7-9 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. ____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date ____ .	6) <input type="checkbox"/> Other: ____ .

## **DETAILED ACTION**

This Office Action is in response to the amendment filed November 26, 2006 for the above identified patent application.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 3, 4, 7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The metes and bounds of the desired patent protection is not fully understood. It is acknowledged that the claims are drawn to a protective cover and not to the combination of a cover and a wheel bearing arrangement (see applicants' remarks filed 11/26/06). However, the claims appear to be positively reciting bearing structure. For example, in claim 8, the limitation "said protective cover comprising: an annular cover-up portion...contacting the exposed annular surface of the magnetic encoder." Similarly, claim 9 defines the protective cover as positively engaging a bearing seal. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3, 4, and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown (USP 3,148,798).

In view of applicant's remarks that the claims are directed to a protective cover and not to the combination of the cover and a bearing (see remarks concerning the claim rejection under 35 USC 112), the claims are rejected below.

Brown discloses a protective cover "which can be used wherever it is desired to close an opening or to enclose the end of a projecting part such as the end of a pipe" and "may be used as a dust and moisture seal and as a shipping protector for threads, pipe, tubing ends, and the like" (column 1, lines 1-31). Referring to the Figures, the cover is formed with an annular cover-up portion for enclosing an annular surface and an engagement wall integral with the annular cover-up portion which is capable of being removably engaged with an inner peripheral surface of a bore, wherein the cover can be removably mounted to a wheel support bearing assembly.

With respect to claim 8, it is understood the cover could be installed so as to contact an encoder of a bearing assembly.

With respect to claim 9, it is understood the cover could be installed so as to contact an elastic sealing element of a bearing assembly.

3. Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Ohtuski et al. (USP 6,692,153).

Ohtuski et al. illustrates in at least Figure 10 a protective cap (18) having an annular cover-up portion enclosing and contacting the exposed annular surface of the magnetic encoder (14); and an engagement wall, integral with the annular cover-up portion, and removably engaged in the wheel support bearing assembly, whereby the protective cap is removably mounted on the wheel support bearing assembly.

4. Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by Message et al. (USP 5,873,658).

Message et al. illustrates a protective cap (15) having an annular cover-up portion, enclosing the exposed annular surface of the magnetic encoder (10), and having a distal end thereof contacting an axially outward end of an elastic sealing element (22) of one of the fixed member sealing units; and an engagement wall, integral with the annular cover-up portion, and removably engaged with the rotatable member, whereby the protective cap is removably mounted on the wheel support bearing assembly.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3, 4, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schottendorf et al. (WO 01/25799) in view of Brown (USP 3,148,798).

In the event applicant claims the combination of the cover and the wheel bearing arrangement, the claims would again be rejected as described below.

Schottendorf discloses a protective cap 9 for use in association with a wheel support bearing assembly which includes an outer member 1 having an inner peripheral surface formed with raceways, an inner member 2 having an outer peripheral surface formed with raceways in alignment with the raceways in the outer member, rows of rolling elements 3 operatively interposed between the raceways in the outer member and the raceways in the inner member, sealing units 4 for sealing respective open ends of an annular working space delimited between the inner and outer members, and a magnetic encoder 5 provided in one of the sealing units and having an annular surface exposed bare to a radial face of the wheel support bearing assembly, the magnetic encoder having a plurality of alternating magnetic poles arranged in a direction circumferentially thereof, said protective cap comprising: an annular cover-up portion for enclosing the annular surface of the magnetic encoder that is exposed bare to the radial surface of the wheel support bearing assembly, and an engagement wall integral with the annular cover-up portion and capable of being removably engaged in the wheel support bearing assembly, whereby the protective cap is removably mounted on the wheel support bearing assembly.

Schottendorf does not disclose the engagement wall engaged with an inner peripheral surface of an axial bore, however it was known to configure a protective cap

with a wall for engaging an axial bore. As described above, Brown discloses a protective cover "which can be used wherever it is desired to close an opening or to enclose the end of a projecting part such as the end of a pipe" and "may be used as a dust and moisture seal and as a shipping protector for threads, pipe, tubing ends, and the like" (column 1, lines 1-31). Referring to the Figures, the cover is formed with an annular cover-up portion for enclosing an annular surface and an engagement wall integral with the annular cover-up portion which is capable of being removably engaged with an inner peripheral surface of a bore, wherein the cover can be removably mounted to a wheel support bearing assembly.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the cover of Schottendorf with engagement means for engaging a bore, as taught by Brown, motivation being to provide a more compact arrangement by eliminating the need to support the cover by the outer peripheral surface of the bearing arrangement.

#### ***Response to Arguments***

7. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Joyce whose telephone number is (571) 272-7107. The examiner can normally be reached on Monday - Thursday 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on (571) 272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
William C. Joyce